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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,980	07/23/2001	Takayuki Suzuki	53375/1439	2298

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EXAMINER

LEUBECKER, JOHN P

ART UNIT PAPER NUMBER

3739

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/909,980

Applicant(s)

SUZUKI ET AL.

Examiner

John P. Leubecker

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-12 and 20-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 9, 11, 12, 21, 22, 24 and 26-30 is/are rejected.
- 7) ☒ Claim(s) 2, 7, 8, 10, 20, 23, 25 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/4/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 4, 9, 11, 12, 24 and 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Laufer et al. (U.S. Pat. 6,494,888).

Laufer et al. disclose a first endoscope (710, Fig.1) having an observation system (715), a holding device (740) extending out of the distal end of the endoscope (note 740 extends through channel 776 which is shown in Figure 1 to extend out of the distal end of endoscope 710), the holding device comprising a distal end portion (740, which can be grasping elements, col.6, lines 55-58) and an elongated portion that passes through a channel (776, col.4, lines 35-40), a first needle (818a, Fig.4B) that is moveable relative to the endoscope (note movement in Figs. 9B and 9C), a second needle (818b, Fig. 4B) positioned beside and spaced apart by a distance from the first needle and a suture (822, Fig.6B). As to claim 3, grasping elements of the holding device as pointed out above would anticipate at least two moveable jaws. As to claims 4 and 27, the needles have a hollow space (827, Fig.6B) disposed therein. As to claims 9 and 24, a suture retaining device includes two jaws (734,732, Fig.4A), wherein one comprises a grasping section (734, Fig.4B) which is capable of grasping the suture (note Fig.8). As to claims 11 and

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28, the first needle and second needle are capable of being moved as claimed (Fig.1). As to claims 12 and 29, the grasping elements of the holding device are capable of holding any tissue and the needles are movable to be positioned where desired. As to claim 26, note that the second needle (818b, Fig.4B) is movable relative to the endoscope and includes a suture (822, Fig.6B).

***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 3, 4, 11, 12, 21, 22 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui et al. (Jap. Pat. Pub. 2000-033071) for the reasons set forth in numbered paragraph 6 of the previous Office Action, paper number 20.

As to claims 1, 3, 4, 11, 12, 21 and 26-30, and as previously pointed out, the channels 15 and 23 are NOT designed for use with any particular treatment tool. The Examiner maintains his position that it would have been obvious to use any combination of treatment tools in any arrangement within the channels. This would obviously include use of two needles since a needle is considered a treatment tool.

As to claim 22, note again note openings at 19, Fig.2 and 38, Fig. 5. Any of these openings are proximal to the distal end.

***Allowable Subject Matter***

5. Claims 2, 7, 8, 10, 20, 23, 25 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

6. Applicant's arguments filed June 4, 2004 have been fully considered but they are not persuasive.

It is noted that although Applicant combined limitations of a claim that was indicated as allowable, not all limitations of that claim and any intervening claim were maintained. Applicant's different combination of elements in amended claim 1 cause a search to be required. Rejections based on the results of that search appear above.

Regarding the rejection under 35 USC 103 in view of Matsui et al. (U.S. Pat. 6,352,503), although the Examiner could not locate ownership information on the instant application, Applicant's statement of common ownership appears to be sufficient to remove Matsui et al. as a reference in the 103 rejection. Since Applicant has recognized that the priority documents (esp. JP 2000-033071) of the Matsui et al. reference are proper references against the present invention (i.e., the same rejection proposed by the Examiner would apply), Applicant has addressed the rejection with respect to those priority documents. Applicants efforts to advance prosecution in this matter are appreciated.

Unfortunately, Applicant's arguments with respect to this rejection do not treat the merits of the obviousness rejection. Instead, Applicant points out the differences between the present invention and JP 2000-033071 as if this reference had been applied as an anticipatory reference.

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The Examiner had recognized that the only difference between the invention of claim 22 and the device disclosed by Matsui et al. (now JP 2000-003071) was which tools were placed in which channels. The Examiner does not think it can be argued that the level of ordinary skill in this art (a level high enough to allow one to make and use a device such as the one shown in JP 2000-033071) would prohibit one of ordinary skill from considering any tool positioned in any of the channels to perform a desired procedure. And, as the Examiner pointed out, the channels were not specifically designed for specific surgical tools, i.e., no one channel is designed for exclusive use by a specific surgical tool, as the specific tools actually used in the JP 2000-033071 device are exemplary of the tools needed in an arbitrary procedure. Accordingly, use of any desired surgical tools in any of the tool channels to perform any desired procedure provides for a motivation to do such since this would increase the functionality and usability of the device disclosed by JP 2000-033071.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yoon (U.S. Pat. 5,797,927)—note device with grasping elements and two needles (Fig. 1).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

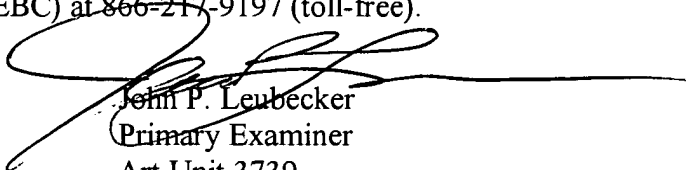
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl